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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,652	01/25/2002	Hideobu Ohya	02040/HG	3492

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NEW YORK, NY 10017-2023

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,652

Applicant(s)

OHYA ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,15,16 and 18-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-14,17 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 1, 4-14, 17 and 27-29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi (6,485,812) for reasons of record and for reasons given below. With respect to the new claims, the limitation of claim 27 is disclosed at col. 16, lines 40-67, the limitation of claim 28 is disclosed at col. 8, lines 49-60 (arc method makes fumed silica) and the limitation of claim 29 is disclosed at col. 11, lines 30-42. The solid content of thermoplastic particles would have been obvious to one of ordinary skill in the art from the disclosure of the reference concerning the proportion of binder in the coating layers and the coating weights for the layers recited at col. 17, lines 18-32.

2. Claims 1, 4, 7, 10, 13, 14, 17, 27 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over either patent to Sunderrajan et al (6,635,319 or 6,347,866) for reasons of record and for reasons given below. With respect to the new claim limitations, US 6,635,319 discloses substrates at col. 4, lines 8-18, and Ropaque®543 which is disclosed by the references inherently has a particle size and glass transition temperature consistent with claims 30 and 31. The limitation of claim 32, which is a compositional and coating weight limitation would have been obvious to one of ordinary skill in the art from the reference in order to obtain properties of good image quality and high gloss attributed thereto.

With respect to the new claim limitations, US 6,347,866 discloses substrates at col. 4, lines 24-33, and Ropaque®543 which is disclosed by the reference inherently has a particle size and glass transition temperature consistent with claims 30 and 31. The limitation of claim 32, which is a compositional and coating weight limitation would

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have been obvious to one of ordinary skill in the art from the reference in order to obtain properties of good image quality and high gloss attributed thereto.

3. Applicant's arguments filed 7/26/04 have been fully considered but they are not persuasive. With respect to the latex particles of Sekiguchi, it is common for latex particles to have glass transition temperatures up to 30 °C. These temperatures may exceed ambient temperatures and therefore, the particles remain on application to the medium. While the particles may lose their form during a calendar treatment, the examiner relies on the stable intermediate that exists prior to the calendaring step for purposes of this rejection.

The particles of the Sunderrajan et al. references have higher glass transition temperatures, within the range of applicants' new claim 31. Applicants' assertions to the contrary, the Sunderrajan et al. references claim the presence of thermoplastic particles in their final products.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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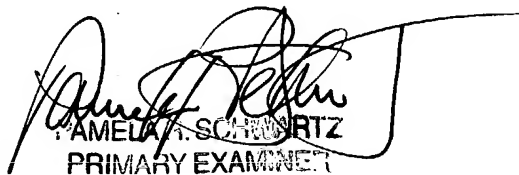
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
October 1, 2004



PAMELA A. SCHWARTZ
PRIMARY EXAMINER